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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,319	11/22/1999	MICHAEL ADRIAN GOOCH	11129/2	3669

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KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER
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KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/447,319

Applicant(s)

GOOCH, MICHAEL ADRIAN

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 22, 25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/7/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed on August 16, 2004. The rejections cited are as stated below:

### ***Response to Applicant's amendment***

2. Applicants' amendment filed on August 16, 2004 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Applicants' request for allowance is respectfully denied.

In response to Applicant's request. A copy of the initialed PTO-1449 form filed on March 5, 2001 is attached to this office action. Also, attached to this office action is a copy of the "BoxLot" reference with the download date of September 22, 1999, and the source of the reference (<http://www.boxlot.com/formats.html>) are printed on the bottom of each page.

### ***Claim Rejections – 35 U.S.C. 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 1-9, 11-19, 22, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402 in view of BoxLot Online Auction, "review auction & bidding formats", hereinafter "BoxLot", as discussed in paragraph 6 of the previous office action mailed on March 17, 2004.

Further: Claims 1-9, 11-19, 22, 25, and 28, Popolo teaches that the second indication does not indicate what the best bid is, so that users receiving the second indication do not know the best bid (column 11, lines 25-31).

Popolo fails to teach that the first indication indicating that the response is the best price response, and the second indication indicating that the response is not the best price response.

However, Popolo teaches that "the system automatically notifies the buyer of the acceptance or rejection by electronic mail, as indicated at block 146. The acceptance or rejection message will appear as new mail in the Electronic Mail Main Menu of the buyer" (column 11, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teachings of Popolo to include that the first indication indicating that the response is the best price response, and the second indication indicating that the response is not the best price response since Popolo's system automatically notifies the buyer of the acceptance or rejection by electronic mail which appears as new mail to the buyer. One of ordinary skill in the art would have been motivated to do so because, it greatly improves the efficiency of the system by providing the user with detailed information, and a system that is user friendly. As indicated in the office action mailed on January 15, 2003.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402 in view of BoxLot Online Auction, "review auction & bidding formats", hereinafter "BoxLot", and further in view of Kalmus et al, U.S. patent 4,674,044 as discussed in paragraph 7 of the previous office action mailed on March 17, 2004.

### ***Response to Arguments***

7. Applicant's requests for the signed IDS form 1449, and a copy of the BoxLot reference are attached to this office action. Applicant's arguments have been addressed in previous office actions, additional arguments are addressed in this office action. In the remarks, the Applicant argues in substance that;

In the Office Action nowhere indicates how users are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response, and the Examiner is asked to cite the specific text language.

In response;

The claimed limitations states "wherein the users, taking into account whether the first indication or the second indication is provided, are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response".

Popolo reference clearly teaches that the users are able to adjust or cancel a corresponding response at any time before the customer accepts the best price response (column 17, lines 35-46), "a buyer may revise a previous bid, not yet accepted, as indicated in block 230." the claim language is not adjusting or canceling a response, the claim states "users are able to adjust or cancel". Furthermore, since adjust or cancel is in the alternative, finding the teaching of either one of them covers the claim language. Therefore, (column 17, lines 35-46, and column 15, lines 22-27) of Popolo meet the claimed limitation.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.

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A handwritten signature in black ink, appearing to read 'H. M. Kazimi', with a stylized flourish at the end.

**HANI M. KAZIMI**  
**PRIMARY EXAMINER**  
Art Unit 3624

December 13, 2004